



14 SEP 2006

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In re Application of
DOUGLAS *et al*
U.S. Application No.: 10/525,581
PCT No.: PCT/GB03/002855
Int. Filing Date: 03 July 2003
Priority Date: 22 August 2002
Attorney Docket No.: 1512.2.148
For: MOBILE 3-PART CRUSHER
ASSEMBLY

DECISION

This decision is in response to applicants' petition under 37 CFR 1.137(b) and 37 CFR 1.47(a) filed 31 July 2006.

BACKGROUND

On 07 November 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 14 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failure to respond to the Form PCT/DO/EO/905 within the time period set therein.

On 31 July 2006, applicants filed a petition to revive under 37 CFR 1.137(b) which was accompanied by, *inter alia*, a petition under 37 CFR 1.47(a); a declaration signed by one of the two named inventors; required fees; statements by Ian Frazier and William McLean Orr; and other assorted documentary evidence in support of the petition under 37 CFR 1.47(a).

DISCUSSION

Petition to Revive Under 37 CFR 1.137(b)

A petition to revive pursuant to 37 CFR 1.137(b) requires: (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the

required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Applicants submitted a declaration executed by one of the two named inventors and a petition under 37 CFR 1.47(a) for the nonsigning inventor. This is considered an appropriate response. Applicants provided the petition fee for a small entity of \$750.00. Applicants' statement in the petition meets the requirement of 37 CFR 1.137(b)(3). A terminal disclaimer is not required.

Applicants' petition to revive under 37 CFR 1.137(b) is **GRANTED**.

Petition Under 37 CFR 1.47(a)

Applicants claim that co-inventor, Paul Douglas refuses to cooperate. A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Petitioners submitted a \$130.00 petition fee using a credit card on 31 July 2006. The \$70.00 difference has been charged to Deposit Account No. 23-3050 as authorized. Item (1) of 37 CFR 1.47(a) is complete.

With regards to item (3), the last known address of co-inventor Paul Douglas is listed as:

17 Woodville Road
Hartshorne, Derbyshire
DE11 7ET, United Kingdom

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by one of the two named co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Regarding item (2), applicants' burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP. Several pertinent segments are listed below:

Where a refusal of the inventor to sign the application papers is

alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Applicants claim that the conduct of the nonsigning inventor constitutes a refusal to cooperate and have provided documentary evidence that would likely constitute such a refusal. However, applicants must also show that a complete copy of the application (specification, claims and drawings) was sent to the nonsigning inventor for the refusal to be accepted. Here, applicants claim that a complete copy of the above-captioned application has been sent to the non-signing inventor, in fact the nonsigning inventor "received multiple copies of the application papers."

However, this assertion is not corroborated by any of the documentary evidence submitted. There is no indication that a copy of the application was sent to Mr. Douglas. Mr. Orr's statement in paragraph three that the international application was "duly reviewed by the inventors prior to filing the International application, on which the present United States application is based" is not sufficient to meet the requirements of the MPEP. Applicants must provide the inventors with a complete copy of the national stage application as filed for a refusal under 37 CFR 1.47 to occur.

For this reason, item (2) of 37 CFR 1.47(a) is not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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